

Application No. 10/036,840  
Amendment dated October 15, 2004  
Reply to Office Action of June 15, 2004

### **REMARKS/ARGUMENTS**

Responsive to the Official Action mailed June 15, 2004, applicant has further amended the claims of her application in an earnest effort to place this case in condition for allowance. Specifically, independent claim 1 has been amended. Reconsideration is respectfully requested.

Applicant notes the Examiner's objection to claim 1, and has revised the claim accordingly.

In rejecting the pending claims under 35 U.S.C. §102 and §103, the Examiner has continued to rely upon PCT publication WO 99/38541, to Nakamura. However, applicant must respectfully maintain that by virtue of the fundamental shortcomings in the teachings of this reference, it simply does not teach or suggest applicant's invention as claimed. In view of this, applicant has taken care to revise her pending claims, and respectfully requests reconsideration.

Applicant gratefully acknowledges the Examiner's careful explanation of her position in interpreting the pending claims, and applying the cited prior art. Upon careful study of the Action, and the cited prior art reference, it is believed that the following clear and significant distinctions exist between the prior art, and applicant's invention as claimed: the prior art contemplates coating of *particulate superabsorbent* with an anti-microbial compound, with the resultant particles employed in an absorbent article, while applicant's invention provides a *uniform admixture* of a hydroxydiphenyl

ether and aliphatic acid carrier, which is then topically applied *in aqueous form* to a base substrate material whereby the odor control compound is present *as a coating* at the surface of the base substrate material. It is respectfully maintained that the prior art simply does not teach or suggest applicant's claimed absorbent article, including a base substrate and odor control compound, as specifically recited.

It is believed that applicant's above characterization of the Nakamura reference is accurate. At page 3, line 25 of Nakamura, it is stated:

The present invention is directed to an anti-microbial hydrogel-forming absorbent polymer comprising a hydrogel-absorbent polymer, and an anti-microbial . . .

At page 6, lines 20 *et seq.* of Nakamura, it is stated:

In a preferred embodiment, the A-HFAP is a mixture of the HFAP and the anti-microbial wherein the anti-microbial is generally present in the HFAP. . . . In preferred embodiments, the HFAP is in the form of discrete units. More preferably, the HFAP particles are in the form of particles, sheets, films, cylinders, blocks, fibers, filaments, or other shaped elements. More preferably, the A-HFAP is particulate.

Preferably, the anti-microbial of the present invention is capable of binding to an HFAP, more preferably capable of binding *to the surface* of an HFAP. In more preferred embodiments, the HFAP particles are coated with anti-microbial. As used herein, the term "coated with" means that the anti-microbial will be on at least a portion *of the surface* of at least one of the particles of the HFAP.

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It is believed that these teachings of the Nakamura reference are clear:  
hydrogel-forming particles are coated with the anti-microbial compound. As such, there is *no uniform admixture* of the hydrogel-forming polymer and anti-microbial agent.

Notably, the Examiner has essentially agreed with applicant's interpretation of the teachings of Nakamura, where she states in her Action that by combining Nakamura with the teachings of U.S. Patent No. 6,287,634, to Beall et al., would "provide a compound that can be combined with a topically-active compound and homogeneously dispersed as *an insoluble, particulate material*."

To further distinguish applicant's claimed article from the Nakamura reference, applicant has further revised her pending claims to specify that the recited odor control compound is present *as a coating* at the surface of the associated base substrate material, by having been topically applied in aqueous form to the base substrate material. By applicant's previous response, applicant noted specific discussion in the Manual of Patent Examining Procedure addressing so-called "product-by-process" claims. In this regard, further reference is made to M.P.E.P. Section 213.05(p), which specifically provides:

A product-by-process claim, which is a product claim that defines the claimed product in terms by which it is made, *is proper* (citations omitted).

Moreover, as specifically provided in M.P.E.P. Section 2113:

*The structure implied by the process steps should be considered when assessing the patentability of product-by-*

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*process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics of the final product (citations omitted).*

The mandate of the M.P.E.P. is clear: the structure implied by the process steps *should be considered* when assessing the patentability of applicant's pending claims. It is believed that the Examiner has fairly characterized the teachings of Namakura, and has noted those portions of the reference upon which she relies upon in her rejection. However, applicant must respectfully maintain that the M.P.E.P. requires that the structure implied by the recited process steps should be considered when assessing patentability, and there is absolutely no question but that Nakamura fails to teach or suggest application of applicant's claimed odor control compound *as a uniform admixture* by topical application *in aqueous form* to the base substrate material.

Moreover, it is respectfully maintained that applicant's claimed odor control article is not only clearly novel from the teachings of the Nakamura reference, but is additionally clearly patentably distinct from the teachings of this reference. Reference is made to M.P.E.P. Section 2143.01, specifying requirements for a proper obviousness rejection, which specifically admonishes that a "proposed modification cannot render the prior art unsatisfactory for its intended purpose, and that a "proposed modification cannot change the principle of operation of a reference." Nakamura is clearly *limited in its teachings* to the application of a anti-microbial compound to hydrogel forming

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particles. There is simply no teaching or suggestion in this reference that applicant's claimed odor control compound can be formed as a *uniform admixture* which is then applied in *aqueous form* to thereby form a *coating* on an associated base substrate material.

Accordingly, it is believed that pending claims 1, 3, 4, and 6-11 are in condition for allowance, and reconsideration is respectfully requested. Should the Examiner wish to speak with applicant's attorneys, they may be reached at the number indicated below.

The Commissioner is hereby authorized to charge any additional fee which may be required in connection with this submission to Deposit Account No. 23-0785.

Respectfully submitted,

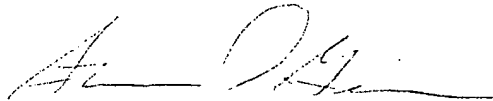
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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage at First Class Mail in an envelope addressed to:  
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on **October 15, 2004**.

A handwritten signature in cursive script, appearing to read "A. D. G.", is written over a horizontal line.